



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Edward J. Panelli

Serial No.: 09/683,791

Filed: February 14, 2002

For: Method and Apparatus for Performing
Economic Analysis of a Radiological
Image Archiving System

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Group Art Unit: 3626

Examiner: Glass, Russell S.

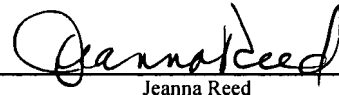
Atty. Docket: GEMS:0158/YOD
15EC6142-1

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Jeanna Reed

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In light of the following remarks, Appellant respectfully requests review of the Final Rejection of the above-identified application, in which the Examiner rejected all pending claims 1-13 and 15-32 under 35 U.S.C. § 103(a). This Request is being filed with a Notice of Appeal. No amendments are being filed with this Request. In view of the following remarks, Appellant respectfully requests reconsideration and allowance of all pending claims.

Legal Error of Rejections under 35 U.S.C. § 103(a)

The Examiner rejected all of the present independent claims 1, 13, 23, and 29 under 35 U.S.C. § 103(a) as being unpatentable over Sarno, (U.S. Pub. 2002/0042751 A1) (hereinafter "Sarno") in view of Jamroga et al., (U.S. Patent No. 6,574,742) (hereinafter "Jamroga"). All of the present independent claims 1, 13, 23, and 29 generally recite a query page adapted to elicit usage information of a radiological imaging system.

Contrary to the legal precedent of the Federal Circuit, the Examiner apparently ignored the present specification in formulating the rejection. Appellant discloses and claims usage of an *imaging* system. The Examiner apparently confused the Jamroga archiving system with an imaging system, as presently disclosed and claimed. First, the plain language of the claims states imaging system. Second, the specification supports the recitation of an imaging system (not an archive system). Appellant kindly reminds the Examiner that the specification is “the primary basis for construing the claims.” *See Phillips v. AWH Corp.*, 75 U.S.P.Q.2d 1321, 1326 (Fed. Cir. 2005) (holding that one should rely heavily on the written description for guidance as to the meaning of the claims).

Thus, because neither reference teaches *usage* of an *imaging* system, the cited combination (the Sarno reference as modified the Examiner via Jamroga), does not teach or suggest all of the features of the present claims. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness. *See Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985) (explaining the Examiner must show that a combination of references includes *all* of the claimed elements). The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979).

In addition, the Examiner apparently has not responded to the distinction between an downstream archive system and an upstream imaging system. The Supreme Court recently stated that the obviousness analysis should be explicit. *See KSR Int’l Co. v. Teleflex, Inc.*, No. 04-1350, page 14 (U.S., decided April 30, 2007). “[R]ejections based on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *See id.* (quoting *In re Kahn*, 441 F.3d 977,988 (Fed. Cir. 2006)).

In the Final Office Action, the Examiner cited paragraphs 12, 15, 17, and 18 of the Sarno reference in support of the rejection. *See* Final Office Action, page 3. The Examiner apparently relied on the graphical user interface, survey generator, user information, and associated financial

analysis in Sarno as disclosing the present query page designed to elicit *usage* of a system. The Examiner then apparently modified (via Jamroga) the Sarno generic system to be an *imaging* system, as claimed.

Initially, Appellant believes that the paragraphs 12, 15, 17, and 18 of Sarno cited by the Examiner are unclear as to whether actual usage information of a system is elicited, even for a generic system. While Sarno discloses survey data, it does not specifically state usage information, but instead makes vague comments such as “the number and identity of factors that should be measured by the methods of the present invention to provide a useful financial analysis.” *See* Sarno, pages 3-4, ¶ 20. Nevertheless, Sarno does *not* teach an *imaging* system (as acknowledged by the Examiner), and Jamroga teaches an *archiving* system, not an actual *imaging* system. Thus, even assuming, *arguendo*, that Sarno taught a query page designed to elicit usage of a system (which Appellant does not concede), neither reference discloses *usage* of an *imaging* system.

In other words, while Sarno discloses an electronic user interface for eliciting generic user information, both Sarno and Jamroga are absolutely devoid of a *query page* designed to elicit or determine existing *usage* of a customer’s *radiological imaging system* (not archiving system). The Examiner stated that a radiological imaging system “is well known in the art as evidenced by Jamroga.” *See* Final Office Action, page 3 (citing Jamroga, col. 1, lines 48-65). However, this cited portion of the Jamroga merely discusses the Digital Imaging and Communications in Medicine (DICOM) standard, and is absolutely devoid of a teaching or suggestion to establish *usage of a customer’s radiological imaging system* over a period of time. Moreover, while Jamroga discusses benefits of converting from a film-based archive system to a digital-based archive system, and mentions that images may be identified by various types of information including the data and time the image was generated, it is plain that Jamroga never addresses establishing a customer’s usage of an *upstream radiological imaging system* over time. *See* Final Office Action, page 6 (citing Jamroga, col. 9, lines 23-33). Neither Sarno nor Jamroga, whether taken alone or in combination, teach or suggest a query page or form (e.g., having a question) used to elicit or determine a customer’s radiological imaging system usage.

In the “Response to Arguments” section of the Final Office Action, the Examiner did not find Appellant’s arguments persuasive. The Examiner stated:

As per applicants argument that Sarno fails to disclose a query page being adapted to elicit a customer’s system usage over the period of time, it is submitted that Sarno discloses such a system. Sarno discloses a survey generator with a series of questions is a query page, and figs. 1C and 1E show information such as historic and future activity costs with associated savings projections over time, (Sarno, figs. 1C, 1E, ¶ 12, 17, 18). Such information is used by Sarno to establish a cost-savings projection for a given period of time based on system usage, storage capacity, or amount of images stored. As stated in the previous office action, it is the combination of such financial analysis with the well-known radiological image archiving system of Jamroga that forms the crux of the rejection. In response to applicant’s arguments against the references individually, one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merk & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)

Final Office Action, page 11 (emphasis added).

To the contrary, again, Appellant respectfully emphasizes that both cited references, whether taken alone or in combination, are absolutely devoid of query page that elicits usage-time information about an *imaging system*. Indeed, again, as the Examiner acknowledged, Sarno does not disclose the eliciting of information about a radiological *imaging system* usage per time. Further, again, the secondary reference, Jamroga, is directed to an archiving system (the delivery and storage of images), and not to the upstream acquisition of the images. This is implicitly acknowledged by the Examiner in his conclusion that Jamroga discloses an archiving system. See Final Office Action, page 11. Appellant believe it is impractical or even impossible in the context of Jamroga (which is directed to the downstream handling of images) to determine the usage of the upstream image acquisition systems, especially of individual image acquisition systems. To be sure, neither reference, whether taken alone or in combination, teaches or suggests information about a radiological *imaging system* usage over time., as claimed

Request Withdrawal and Review of Final Rejections

In view of the foregoing, Appellants respectfully request that the Examiner withdraw the rejection and allow pending claims 1-13, and 15-32. Further, Appellants respectfully request review of the Final Rejections prior to filing of an Appeal Brief in the present application.

Respectfully submitted,

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